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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,314	10/29/2003	Michael J. Czaplicki	1001-012C1	6565

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/696,314

Applicant(s)

CZAPLICKI, MICHAEL J.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 28-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05212004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

2. If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior

application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed (claimed method).

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 18. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

5. The information disclosure statement filed 5-21-04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. No copy of the foreign patent documents and non-patent literature documents the examiner has lined-thru in the IDS have not been received.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 46-47** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 46 is incomplete. See last line.

Claim 47 recites “the thermally activated polymeric material” which lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 28-31, 34, 35, 37 and 40-45** are rejected under 35 U.S.C. 102(b) as being anticipated by Ward et al. (US3025596).

Ward et al. teach a method for forming a reinforced hydroform comprising: providing a first tubular structure **12** having an outer surface, disposing an adhesive structural material **14** (Col. 3, lines 60-65, described as “cementing agent”).

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In addition, the limitation “adhesive structural material” in claim 28 of the instant invention is broadly written. Therefore, the braze alloy including the cementing agent and paste of metal powder as described in col. 3, lines 60-65 of Ward et al. could be considered “an adhesive structural material”.) upon the outer surface with an applicator (sprayed), hydroforming (figure 6b) the first tubular structure **12** while the adhesive structural material **14** is located upon the outer surface thereby forming a hydroformed contour of the first tubular structure **12** with the adhesive structural material **14** located upon the contour.

Regarding claims 29, 30 and 40-44, a second tubular structure **10** is adhered to the adhesive structural material **14**. Note the hydroforming with the adhesive structural member **14** located within an open bore the second tubular structure **10**.

Regarding claims 31, 37 and 45, the brazing material of Ward et al. is heated. During heating, the brazing material clearly will expand and will liquefy. Therefore, Ward et al. is considered to meet the limitation “adhesive structural material is expandable at a temperature greater than its glass transition temperature”.

Regarding claims 34-35, note that the second tubular structure **10** is metal/steel.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 32, 36, 38, 39 and 46** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al.

Regarding claims 32 and 38, in col. 3, lines 49-65, Ward et al. teach that the “adhesive structural material” could be applied using a number of methods including spraying, wrapping, electroplating and envelopment. Ward et al. do not specifically teach that the applicator is an extruder and the specific temperature used. However, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have used an extruder in place of other methods of application, in order to provide an even thickness. In addition, official notice is taken that it was well known to person of ordinary skill in the art, to have used a specific temperature range in order to provide effective bonding by heating of the adhesive structural material depending upon the type of material used.

Regarding claims 36 and 46, Ward et al. do not specifically teach what the tubular structure is used for. However, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention to use tubular structures for vehicles, in order to provide frame structures, piping or tubing.

Regarding claim 39, Ward et al. teach that the adhering step is performed after hydroforming rather than before hydroforming as claimed. At the time of the invention, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have performed adhering after hydroforming because applicant has not disclosed that adhering being performed after hydroforming provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the adhering before hydroforming taught by Ward

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et al. or the claimed adhering being performed after hydroforming because either hydroforming methods perform the same function of securing the tubular arrangement equally well.

12. **Claims 33 and 47** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al. in view of Wycech (US5884960).

Ward et al. teach the invention cited with the exception of the expandable material being epoxy based.

Wycech teaches a similar tubular arrangement with an inner **68** and outer tube **66** having an expandable epoxy material **70**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Ward et al. with the expandable material being epoxy based, in light of the teachings of Wycech, in order to provide a light weight and reinforced tubular arrangement.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 28-47 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,668,457. Although the conflicting claims are not identical, they are not patentably distinct from each other.

For example, claim 28 recites “providing a first tubular structure having an outer surface” (see col. 7, lines 22-23 of claim 1 of the patent), “disposing an adhesive structural material upon the outer surface with an applicator” (see col. 7, lines 26-29 and 35 of claim 1 of the patent), “hydroforming the first tubular structure while the adhesive structural material is located upon the outer surface thereby forming a hydroformed contour of the first structural material located upon the contour” (see col. 7, lines 30-33 of claim 1 of the patent).

It is clear that all of the elements of claim 28 are to be found in claim 1 of the patent. The difference between claim 28 of the application and claim 1 of the patent lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 1 of the patent is in effect a “species” of the “generic” invention of claim 28. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 28 is anticipated by claim 1 of the patent, it is not patentably distinct from claim 1.

Claims 29/40/44/46 can be found in col. 7, lines 30-33 of claim 1 of the patent.

Claims 30/41 can be found in col. 7, lines 30-33 of claim 1 of the patent.

Claim 31/45 can be found in claim 5 of the patent.

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Claim 33 can be found in claim 7 of the patent.

Claim 34 can be found in claim 8 of the patent.

Claim 35 can be found in claim 12 of the patent.

Claim 36 can be found in claim 9 of the patent.

Claim 37 is inherently met because 0% means no change.

Claim 38 can be found in claim 11 of the patent.

Claim 39 can be found in claim 1 of the patent.

Claims 42/43 can be found in claim 1 of the patent.

Claim 47 can be found in claim 24 of the patent.

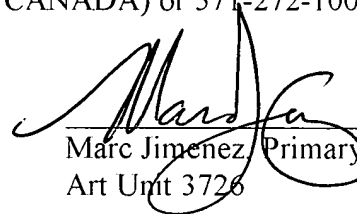
The patent does not claim using an extruder as recited in claim 32 of the instant invention. However, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have used an extruder in place of other methods of application, in order to provide an even thickness.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (571) 272-4530. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Marc Jimenez Primary Examiner
Art Unit 3726

MJ
5-25-06